



REMARKS/ARGUMENTS

The Examiner is thanked for the performance of a thorough search. By this amendment, Claims 1-6, 8-9, 16-17, 19-20, 23-27, 29, 34, and 37 have been amended to more distinctly claim the invention. No claims have been added or cancelled. Hence, Claims 1-37 are pending in the application.

SUMMARY OF THE REJECTIONS/OBJECTIONS

Claims 1-3, 5, 7, 9-19, 22-25, and 29-37 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Published App. 2001/0027474 to Nachman et al. ("Nachman") in view of U.S. Published App. 2001/0018658 issued to Kim ("Kim"). Claims 6, 20, 21, and 26-28 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Nachman in view of Kim in further view of U.S. Published App. 2002/00169875 to Furui et al. ("Furui"). Claims 4 and 8 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Nachman in view of Kim in further view of U.S. Published App. 2002/009977 to Gupta ("Gupta"). In addition, Claim 27 was rejected under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

THE REJECTIONS BASED ON SECTION 112

Claim 27 was rejected under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the invention. Claim 27 has been amended. Specifically, amended Claim 27 recites:

The method of claim 26, wherein **disabling, at least with respect to the guest user, at least one feature of the client side instant messaging application software on said registered user client computer system** includes a **disabling** feature that would otherwise have allowed the selected registered user to add the temporary user identification assigned to the guest user to a list of users whose online presence is monitored by the client side instant messaging application software installed on said registered user client computer system.

The Applicants respectfully note that the amendment to Claim 27 is supported by the

Specification. For example, the present application states, “[i]n one embodiment, all of the icons normally included in the tool bar 1212 are displayed when the other participant is a guest user, but certain functions may be disabled by operation of the client side instant messaging application software when the other participant is a guest user.” (See Page 34, line 24 – Page 35, line 5). Thus, Applicants respectfully submit that Claim 27 is patentable under 35 U.S.C. § 112, second paragraph. For at least this reason, the Applicants submit that Claim 27 is in condition for allowance.

THE REJECTION BASED ON AN ALLEGED NACHMAN-KIM COMBINATION

Claims 1-3, 5, 7, 9-19, 22-25, and 29-37 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Published App. 2001/0027474 to Nachman et al. (“Nachman”) in view of U.S. Published App. 2001/0018658 issued to Kim (“Kim”). This rejection is respectfully traversed.

INDEPENDENT CLAIM 1

Amended independent claim 1 currently recites:

A method for enabling a guest user who is not a registered user of an instant messaging system to communicate by instant messaging with a registered user of the system, the method comprising:

receiving an **initial** indication that the guest user desires to communicate with a **selected registered user by instant messaging, wherein the initial indication specifically identifies the selected registered user with whom the guest user desires to communicate;**

sending to a client computer system associated with the guest user browser-executable computer code comprising computer instructions for providing at least limited instant messaging functionality to the guest user at the client computer system, without requiring the guest user to download and install client side instant messaging application software and without requiring the guest user to register as a user of the instant messaging system; and

facilitating an instant messaging session between the guest user and the selected registered user.

Claim 1 provides an advantageous method for enabling guest users to communicate with registered users by instant messaging. By allowing a guest user to indicate a selected registered user with whom the guest user would like to communicate by instant messaging, it is possible to facilitate an instant messaging session (and hence, allow greater communication) between non-registered and registered users. In connection with an indicated selection to communicate, a guest user's client computer system receives browser-executable computer code that facilitates communication without requiring the guest user to register as a user of the instant messaging system. Thus, with the method of claim 1, a guest user is able to utilize many of the benefits of an instant messaging system without downloading and installing client side instant messaging application software or requiring every user to register.

Such a method is neither taught nor suggested by Nachman or Kim. Instead, Nachman discloses a method in which messages are exchanged between registered viewers of a WWW page (See Nachman, Abstract) and Kim describes a method for allowing registered users to contact guests as they navigate in a virtual world. (See Kim, Abstract and ¶ 43). There is no mention in Nachman or Kim of initially allowing a guest user to indicate and then communicate with a selected registered user by instant messaging.

In support of its rejection, the Office Action correctly notes that Nachman does not teach or suggest "not requiring the guest user to register as a user of the instant messaging system." (See Office Action, Page 2). The Office Action alleges that combining Kim with Nachman "teaches not requiring the guest user to register as a user of the instant messaging system." (See Office Action, Page 2). Specifically, the Office Action cites paragraphs 41 and 60 of Kim in support of this alleged teaching. Thus, the Office Action reasons, Kim allegedly teaches receiving an indication that the guest user desires to communicate with a registered user. (See Claim 1). The Applicants respectfully disagree with this reasoning.

First of all, the Applicants respectfully submit that amending claim 1 to more distinctly claim the invention in and of itself puts the claim into condition for allowance. Moreover, the Applicants have carefully reviewed Kim and there is nothing in Kim that teaches or suggests "receiving an initial indication that the guest user desires to communicate with a selected registered user by instant messaging, wherein the initial indication specifically identifies the selected registered user with whom the guest user desires to communicate."

Kim describes a virtual world in which helpees and helpers participate. However, the Kim system does not allow non-registered user to initially indicate and communicate with a selected registered user. Instead, a helpee in the Kim system “selects a help-request button of a toolbar in a chatting client and enters a message requesting help in an input window. The request is transmitted to a chatting server. The server **sends a signal to all the users in the same site**, informing that a helpee requested help. The client that received the signal from the server displays the icon next to the helpee's ID and messages in a chatting history window in a different color, for example, red, blue, etc. In this manner, the other users can know the appearance of a helpee. In other words, the fact that a user requested help is announced through a color change of icon and messages. A user who tries to help the helpee (or a helper) clicks the icon changed in color to start a help-helpee item. The helper selects the help-helpee item to display a new window on the screen, and enters messages for giving help.” (See Kim, ¶ 62). In other words, Kim users (registered or unregistered) initially send a broadcast message to all available helpers and not to a “selected registered user” when attempting to communicate with other users. Only after a helpee has sent the general broadcast message can a Kim user contact the helpee. This clearly differs from “receiving an initial indication that the guest user desires to communicate with a selected registered user by instant messaging, wherein the initial indication specifically identifies the selected registered user with whom the guest user desires to communicate” as recited in Claim 1. For at least this reason, the Applicants submit that the Office Action’s rejection does not hold.

In addition, the Office Action reason for combining the two references states that “it would have been obvious to one of skill in the art to combine the Nachman’s invention with Kim’s guest user system in order to enhance user’s convenience and usability of virtual worlds by means for representing a user by a representative in the virtual world.” The Applicants respectfully note that such a teaching is not found in either Nachman or Kim. In fact, Nachman teaches a system that requires registration in order to be useful. Nachman describes a system “for monitoring Internet users browsing habits and web page preferences.” (See Nachman, ¶ 16). To do so, a user is required to register so that “user details are stored on the Web Messaging central Server. In one embodiment of the present invention, user information may also be stored on the client browser program by means of HTTP or WAY cookies. Upon registration, the UID code assigned to the user is stored on the web browser's cookie file and on

each access to a WMS, the UID code serves to identify the user according to the registered details included in the WMCS database.” (See Nachman, ¶ 40). Providing the user details through the registration process is what allows Nachman to monitor Internet usage. Contrary to the Office Action’s assertion, guest users would not enhance user convenience. It would make tracking Internet usage more difficult since the identity of a user would not be clear.

In a similar fashion, Kim describes a system where points are granted to helpers as they help helpees. Allowing guest users to initially contact selected users would run contrary to its helper/helpee point system, which allows helpers to initiate contact with helpees in order to gain points. (See Kim, ¶ 25). Thus, the alleged combination of Nachman and Kim does not enhance user convenience. Moreover, the alleged combination runs contrary to what both references teach.

Since an alleged Nachman-Kim combination does not allow a guest user to initially indicate and communicate with a selected registered, the alleged Nachman-Kim combination does not teach or suggest all the elements of Claim 1. For at least this reason, the Applicants submit that Claim 1 is patentable over Nachman and Kim, alone or in an alleged combination.

Dependent Claims 2-3, 5, 7, 9-19, and 22-25

Dependent Claims 2-3, 5, 7, 9-19, and 22-25 depend from Claim 1, and hence, incorporate all of the limitations of Claim 1. These claims also recite further advantageous aspects of the invention. The Applicants submit that claims 2-3, 5, 7, 9-19, and 22-25 are patentable over an alleged Nachman-Kim combination for at least the same reasons as those given above in connection with Claim 1.

Claims 29-37

Independent Claim 29, 34, and 37 are respectively a method claim, a system claim, and a computer readable storage medium claim which contain limitations reasonably analogous to Claim 1. The Applicants submit that Claims 29, 34, and 37, along with their Dependent Claims 30-33 and 35-36 are patentable over the alleged Nachman-Kim combination for at least the reasons given above.

THE REJECTION BASED ON AN ALLEGED NACHMAN-KIM-FURUI COMBINATION

In the Office Action, Claims 6, 20, 21, and 26-28 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nachman in view of Kim, further in view of U.S. Published App. 2002/00169875 to Furui (“Furui”). This rejection is also respectfully traversed.

Claims 6, 20, 21, and 26-28 depend from Claim 1, and hence, incorporate all of the limitations of Claim 1. Thus, if Claim 1 is patentable over Nachman and Kim, then it follows that Claims 6, 20, 21, and 26-28 are also patentable over Nachman and Kim.

As argued above, Nachman and Kim fail to teach or suggest at least the first element of Claim 1. Furui also fails to teach or suggest this element (and the Office Action has not asserted that Furui teaches or suggests this element). Thus, even if the references were combined (assuming *arguendo* that it would have been obvious to combine the references), the combination still would not produce the method of Claim 1. Thus, the Applicants submit that Claim 1 is patentable over Nachman, Kim, and Furui, taken individually or in an alleged combination. The Applicants further submit that Claim 6, 20, 21, and 26-28, which depends from Claim 1 and which recites further advantageous aspects of the invention, are likewise patentable over any alleged combination of Nachman, Kim, and Furui for at least the reasons given above in connection with Claim 1.

THE REJECTION BASED ON AN ALLEGED NACHMAN-KIM-GUPTA COMBINATION

In the Office Action, Claims 4 and 8 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nachman in view of Kim, further in view of U.S. Published App. 2002/0099777 to Gupta (“Gupta”). This rejection is also respectfully traversed.

Claims 4 and 8 depend from Claim 1, and hence, incorporate all of the limitations of Claim 1. Thus, if Claim 1 is patentable over Nachman and Kim, then it follows that Claims 4 and 8 are also patentable over Nachman and Kim.

As argued above, Nachman and Kim fail to teach or suggest at least the first element of Claim 1. Gupta also fails to teach or suggest this element (and the Office Action has not asserted that Gupta teaches or suggests this element). Thus, even if the references were combined (assuming *arguendo* that it would have been obvious to combine the references), the combination still would not produce the method of Claim 1. Thus, the Applicants submit that Claim 1 is patentable over Nachman, Kim, and Gupta, taken individually or in an alleged

combination. The Applicants further submit that Claim 4 and 8, which depends from Claim 1 and which recites further advantageous aspects of the invention, are likewise patentable over any alleged combination of Nachman, Kim, and Gupta for at least the reasons given above in connection with Claim 1.

CONCLUSION

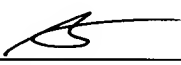
For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Brian D. Hickman
Reg. No. 35,894

2055 Gateway Place, Suite 550
San Jose, CA 95110-1089
(408) 414-1080
Date: November 18, 2005
Facsimile: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

on 11/14/05 by Judy Paradoga
Judy Paradoga